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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,755	08/30/2001	Kulvir Singh Bhogal	AUS920010510US1	9948

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Duke W. Yee
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380

EXAMINER

POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,755

Applicant(s)

BHO GAL ET AL.

Examiner

Peter Poltorak

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Amendment, and remarks therein, received on 10/31/05 have been entered and carefully considered.
2. The Amendment introduces new limitations into the originally sole independent claims 1,6, 11, 15 and 19 that required a new search and consideration of the pending claims. The new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.
3. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4, 8, 14 and 17 are directed towards storing personal identification information in "one of a server and memory on the telephone based on a user selected preferences". However, the closest specification text related to this issue: "if the user does choose to save the card, it is either saved in local storage or sent to a server and saved in the user's file (step 707)" (*the specification*, pg. 20). The specification recites that the user can save the card but stops short from disclosing a user selection of the location where the personal identification information would be

store. Also, the specification does not describe how a user is presented with a choice of available saving locations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
6. "The receiving device" recited in claims 5 and 10 lacks antecedent basis. Furthermore, the only receiving device recited in the preceding claim 1 is a telephone but claim 5 accepts possibility that the device could be a voicemail system.
7. Claims 1, 6, 11, 15 and 19 "The invention comprises sending a communication transmission, and concurrent with receiving the communication transmission, sending a second transmission, wherein the second transmission contains personal identification information about the party sending the communication transmission."
8. The plain definition of "concurrent" is equivalent to "at the same time". Without undo experimentation it would not be clear how the second transmission could be sent at the same time as the first transmission. It is also not clear whether applicant is trying to single out only concurrent transmission of textual personal identification information or whether claim language attempts to point out that the first transmission is independent from (do not conflict with) the second transmission.

9. The specification does not clarify these issues but suggests that the indented meaning of the word "concurrent" is similar to the meaning of "during the same session" (*the specification pg. 17 line 6 0 pg. 18 line 30*).
10. Claims 2-4, 7-9, 12-14, 16-18 and 20 are rejected by virtue of their dependence.

Claim Rejections - 35 USC § 102

The following is a quotation of 35 U.S.C. 102(e) which forms the basis for all obviousness rejections set forth in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-2, 5-7, 10-12 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by *Wu* (*U.S. Patent No. 6744874*).
12. *Wu* invention is directed towards the separation of the user phone number from the physical phone number (*col. 2 lines 63-65*) wherein an individual move can update the physical phone number.

13. As per claims 1-2 and 5 *Wu* teaches message in message communication mode wherein during the communication in one type of message, another type of message can be transmitted and displayed properly (*e.g. col. 4 lines 58-61*).
14. Specifically *Wu* discloses that during the communication in one type of message, another type of message is transmitted and displayed properly. The second message can be transmitted over the same physical connection. For example, during a normal telephone conversation, one provides her telephone number and address in the text form and the other party sees the information on a display device, thus increasing the efficiency and avoiding possible errors in recording such information. The text information can be provided in a digital form by the well-known Frequency-shift Keying (FSK) or Phaseshift Keying (PSK) methods. The text can be displayed just like the Caller ID with Name is displayed in the prior art method. In this case, additional line seize is not necessary for the transmission of the text message since the same physical connection can be used for both messages. The display device detects the second message and displays it accordingly. This can occur simultaneously with the voice conversation. Examples of this type of message-in-message mode includes short text messages during a telephone conversation (*col. 13 lines 22-47*).
15. *Wu* provides an example where a customer initiates a phone call to a merchant to place an order by telephone. Upon the merchant receiving the phone call the customer provides his name and address in text form through the message-in-

message method during the telephone conversation and the merchant will receive the message (*col. 15 lines 50-62*).

16. This reads on "using a telephone to send the communication transmission concurrent with a second transmission over the communication link, wherein the second transmission contains textual personal identification information about the party sending the communication transmission, and wherein the personal identification information is independent of an identity of the telecommunication device used to send the communication transmission".

17. Claims 6-7, 10-12 and 15-16 are substantially equivalent to claims 1-2 and 5; therefore claims 6-7, 11-12 and 15-16 are similarly rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3-4, 8, 13-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wu* (U.S. Patent No. 6744874) in view of Official Notice.

19. *Wu* teaches sending the personal identification information using a telephone device as discussed above.

20. As per claims 3-4, 8, 13-14 and 17 *Wu* does not explicitly teach storing the personal identification information on a telephone device or a server and retrieving the

personal identification information from the server for inclusion in the second transmission.

21. The Official Notice is taken that it is old and well-known practice to store information on the memory on the communication device (*e.g. names, telephone numbers, addresses, Jha et al., U.S. Patent No. 6407949, col. 6 lines 23-31*) and a server (*such as a business card managing server, Ukigawa et al. U.S. Publication No. 20010020239, Fig. 1 and 2*). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to allow the user to select storing the personal identification information on the telephone or on a server from where the information could be retrieved. One of ordinary skill in the art would have been motivated to perform such a modification given benefit of alleviating the need of manual process of entering the information into a telephone so that it could be quickly retrieved as well as providing ability to save the information in place that could be readily available for mobile users regardless of a location of a user or a device used as well as providing at least information backup capability.

22. Claims 9 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wu* (U.S. Patent No. 6744874) in view of *Engelke et al.* (U.S. Patent No. 5974116).

23. *Wu* teaches the two concurrent transmissions as discussed above.

24. As per claim 19 *Wu* does not teach that the first communication transmission's frequency range is different from the second frequency range of the second communication transmission.

25. *Enelke et al.* teach two frequency ranges for two communication transmissions (*col. 4 lines 50-64*).

26. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use different range for the two communication transmission as taught by *Enelke et al.* One of ordinary skill in the art would have been motivated to perform such a modification so that the electronics would not confuse any elements of the spoken word with digital communications.

27. As per claim 9, 18 and 20 *Enelke et al.* teach using frequencies between 2800 and 3500 Hertz and suggest allocating upper band to the text (*col. 4 lines 50-64*).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

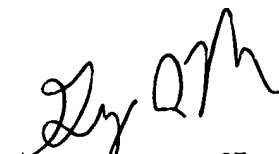
- ❖ Kanzaki et al. (Japanese Publication No. 10-327245),
- ❖ Hur et al. (Korean Patent No. 2001091513),
- ❖ Kanefsky (U.S. Publication No. 20030036393),
- ❖ Alperovich et al. (U.S. Patent No. 6317609),
- ❖ Lunsford et al. (U.S. Publication No. 20020065065),
- ❖ Clark et al. (U.S. Clark et al.),
- ❖ Schuster et al. (U.S. Patent No. 6446127),
- ❖ Avaya ("PDA-to-PDA Communications and WaP-Enabled Streaming Text to Avaya Enterprise Class IP Solutions (Eclips) Telephones, Enhances IP Agent with Increased Remote Agent Functionality, June 19, PRNeswire).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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GREGORY MORSE
SUPERVISOR IN CHARGE EXAMINER
TECHNICAL CENTER 2100